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LYON & HARR, LLP
300 ESPLANADE DRIVE, SUITE 800
OXNARD, CA 93036

EXAMINER	
BECKER, SHAWN M	
ART UNIT	**PAPER NUMBER**
2173	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/556,223	TAFOYA ET AL.	
	Examiner	Art Unit	
	Shawn M. Becker	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-36 and 38-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-17,21-36 and 38-53* is/are rejected.

7)☒ Claim(s) *18-20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to communication filed 5/5/04.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novell GroupWise 5.5 (as supported by "GroupWise User's Guide for Windows 95/98/NT" (hereinafter GroupWise) and the Novell articles entitled "GroupWise 5.x & 6.x" and "MAPI") and U.S. Patent No. 6,421,678 to Smiga et al. (hereinafter Smiga).

Referring to claim 48, GroupWise teaches automatically generating a dynamic list of entries containing contact information (i.e. Frequent Contacts), comprising scanning a data store containing electronic files including emails (see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages, created by e-mail clients) and database files. For example, each entry entered in the Address book (i.e. first figure on page 130) is a database file.

Although GroupWise discloses these several different file types within the data store from which contact information may be automatically extracted, GroupWise does not explicitly show that these file types include one of word processor files, spreadsheet files, and presentation files, in which the entire contents of one of such file types is scanned and any contact information within is extracted. However, Smiga discloses a method of performing lexical

analysis on free form text, such that contact information is parsed out and available for several applications that typically are integrated or work together (i.e. word processors, spreadsheets, databases, etc.) See col. 5, line 59 – col. 6, line 13 and col. 8, line 61 – col. 9, line 25. Since a word processor file consists of free form text, it would have been obvious to one of ordinary skill in the art to parse (examine) complete word processor documents in the data store of GroupWise such that any contact information within the contents is extracted as shown in Smiga to integrate word processor applications with email applications as supported by Smiga.

GroupWise discloses extracting contact information from the scanned files and populating the list with the information extracted from the scanned files. See page 124, under heading "Using Frequent Contacts".

Regarding claim 49, GroupWise teaches the data store has a plurality of types of electronic files, including sent and received e-mail (see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages); email addresses and contacts that exist within previous systems (see page 133, under "Sharing an Address Book with Another User"; where GroupWise discusses sharing another user's address book, which has previously been used on a previous system by a different user, including their email addresses and contacts in their address book); email stores located on public servers (see page 111, where GroupWise discloses the use of LDAP servers, and retrieval of contact information from those public servers); current and previous contact databases (see pages 129-131, where GroupWise discloses using a current contact database; and page 133, under "Sharing an Address Book with Another User"; where GroupWise discusses sharing another user's address book, which has previously been used on a

previous system by a different user, including their email addresses and contacts in their address book); and data embedded within application electronic files (see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages, created by e-mail clients). Also, see each entry entered in the Address book (i.e. first figure on page 130), which is a database file.

Referring to claim 50, GroupWise teaches the contact information includes an email address (see the figure on page 124).

Referring to claim 51, GroupWise automatically provides completion information via a user interface from an entry in the list based on a partial match to user input. See page 111, the paragraph preceding the Tips section.

Referring to claims 52, GroupWise excludes particular electronic files within the data store from scanning. See page 110, under heading "Defining Name Completion Search Order", where GroupWise discloses allowing users to add or remove address books to be included in the "Name Completion" search feature.

Referring to claim 53, GroupWise teaches excluding specific e-mail addresses (see pages 134 and 135, under "Viewing Groups, Organizations, or Resources in the Address Book"; where GroupWise discloses applying filters so that items in the data store are excluded and not displayed; and see pages 149-154; where GroupWise discloses specific filters including e-mail addresses are specified to exclude).

3. Claims 1-3, 5-17, 21-22, 24-36, 38-43, 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novell GroupWise 5.5 (as supported by "GroupWise User's Guide for Windows 95/98/NT" (hereinafter GroupWise) and the Novell articles entitled "GroupWise 5.x &

6.x" and "MAPI"), U.S. Patent No. 6,421,678 to Smiga et al. (hereinafter Smiga), U.S. Patent No. 6,208,339 to Atlas et al. (hereinafter Atlas), and U.S. Patent No. 6,151,624 to Teare et al. (hereinafter Teare).

Regarding claims 1, 10-11, and 32 GroupWise teaches a method and system for automatically extracting contact information from a data store by scanning any of a plurality of files types in a data store. For example, see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages. The figure on page 126 shows the different file types from which contact information (addresses) may be saved (extracted). Page 110, the second tips box, teaches extracting contacts from a foreign address book, which are another file type, and entries in the standard address book as shown in the first figure on page 130 make up yet another file type from which contact information is extracted. GroupWise discloses maintaining/populating a list of at least one contact entry derived from the information extracted (see page 124, under heading "Using Frequent Contacts to Address Items"; where GroupWise displays an example list of contacts derived from the capturing of data); tracking contact information associated with the entry (see page 126, step 4; where GroupWise discloses tracking the time from the last use of the contact's information); and resolving contact entries in real time by providing the most probable specific contact entries from the maintained list (see pages 123 and 125, in the "Tips" shaded box; where GroupWise discloses using "Name Completion", which looks up the name being typed in real time from the maintained list of contact entries).

Although GroupWise discloses several different file types within the data store from which contact information may be automatically extracted, GroupWise does not explicitly show

that these file types include one of word processor files, spreadsheet files, and presentation files, wherein the extracting contact information includes automatically examining the complete contents of one or more of the files in the data store and extracting any contact information located within those contents. However, Smiga discloses a method of performing lexical analysis on free form text, such that contact information is parsed out and available for several applications that typically are integrated or work together (i.e. word processors, spreadsheets, databases, etc.) See col. 5, line 59 – col. 6, line 13 and col. 8, line 61 – col. 9, line 25. Since a word processor file consists of free form text, it would have been obvious to one of ordinary skill in the art to parse (examine) complete word processor documents in the data store of GroupWise such that any contact information within the contents is extracted as shown in Smiga to integrate word processor applications with email applications as supported by Smiga.

Although GroupWise and Smiga teach alphabetizing entries of the maintained list which gives weight to the entries closest to the front of the alphabet (see image on page 124; where GroupWise discloses the maintained list being weighted by alphabetical order), GroupWise does not explicitly describe automatically computing a weight for each entry in the list and providing specific contact entries based on the weight of each entry in the list as claimed. However, Atlas describes a method of auto completing entries in a field (i.e. an email address field and other contact information as in col. 1, lines 45-51 of Atlas), which maintains a list of entries, sorts the entries by frequency of use or most recently used (col. 4, lines 16-20), and presents specific (most probable) entries from the maintained list based on the weight of each entry in the list (col. 4, lines 55-60). Fig. 7 and col. 4, lines 37-63 describe how the user can select to have a list of possible best matches displayed, which may be sorted based on frequency or alphabetically.

While, it is generally accepted that frequency of use and most recently used attributes are weighting factors, GroupWise, Smiga, and Atlas do not explicitly teach computing a weight for each entry in the list. However, Teare describes a name resolution method that assigns a weight to each entry in the list, which may be based for example on the most recent resolution, similar to Atlas. See Teare at col. 21, lines 53-62.

It would have been obvious to one of ordinary skill in the art to modify the contact resolution method of GroupWise, Smiga, and Atlas to automatically compute a weight for each item in the list in order to order entries in the contact resolution list according to the most likely contact, such as the most frequently (or recently) used entries in the list and provide specific entries based on the weight of each entry as supported by Atlas and Teare (Teare at col. 21, lines 30-62). One would have been so motivated in order to provide a best guess for faster selection of the desired entry.

Regarding claims 2 and 27, GroupWise teaches a data store including sent and received e-mails, which are electronic documents (email files) and scanned upon entering the data store (see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages).

Regarding claim 3, GroupWise teaches the data store further includes a plurality of electronic documents including one or more database files. For example, each entry entered in the Address book (i.e. first figure on page 130) is a database file.

Referring to claim 5, GroupWise describes tracking the number of times that an entry has been used (page 124, under heading "Using Frequent Contacts", last line of first paragraph). Also, the combination of GroupWise, Smiga, Atlas, and Teare, *supra*, dynamically updates the

weight of an entry based on the number of times that the entry has been used in order to base the displayed list upon frequency of use (Atlas at col. 4, lines 55-60 and Teare at col. 21, lines 53-56 and col. 22, lines 9-15). It would have been obvious to one of ordinary skill in the art to sort the displayed entries in the list of GroupWise based on frequency of use as described by Atlas and Teare, because the items most frequently used are likely to be used again as supported by Atlas and Teare.

Referring to claims 6-8, GroupWise describes tracking the time since an email using the contact data of the entry was sent/received/added (i.e. page 124, under heading "Using Frequent Contacts" and page 126). Also, the combination of GroupWise, Smiga, Atlas, and Teare, *supra*, dynamically updates the weight of an entry based on the times that the entry has been used in order to base the displayed list upon most recentness of use (Atlas at col. 4, lines 15-20 and Teare at col. 21, lines 53-56 and col. 22, lines 9-15). It would have been obvious to one of ordinary skill in the art to sort the displayed entries in the list of GroupWise, Smiga, Atlas, and Teare based on recentness of use as described by Atlas, because the items most recently used are likely to be used again as supported by Atlas.

Referring to claim 9 and 28, the combination of GroupWise, Smiga, Atlas, and Teare, *supra*, discloses updating the weight of an entry as new information enters the data store. As an example, GroupWise and Atlas track the number of times an entry has been used, which is new information that enters the data store and updates the matching entries weight (frequency of use). See Atlas at col. 4, lines 15-20 and Teare at col. 21, lines 53-56 and col. 22, lines 9-15.

Referring to claim 12, the combination of GroupWise, Smiga, Atlas, and Teare, *supra*, to provide the most frequently used close matches inherently provides the entry having the greatest

weight where one or more entries match an input. Atlas and Teare describes providing an entry weighted by frequency of use, which first provides the most frequently used (highest weighted) entry, even if two entries match an input. See col. 21, lines 39-62 of Teare.

Regarding claims 13-15, 22, 39-40, and 46, GroupWise teaches constraining/changing the size of the list to improve performance of automatically resolving contact entries and using or excluding certain existing contact databases/electronic files (see page 110, under heading "Defining Name Completion Search Order"; where GroupWise discloses allowing users to add or remove address books to be included in the "Name Completion" search feature). With respect to claim 15, GroupWise teaches a user disabling the list (see page 110, Step 4).

Regarding claims 16 and 41, GroupWise teaches new entries are added to the list as new information enters the data store (see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from new received email messages).

Referring to claim 17, the memory to store the list in GroupWise cannot be unlimited; therefore, if the list is full, new entries must replace entries.

Regarding claims 21, GroupWise teaches adding new entries to the list after they are first used and their new information enters the data store (see page 124, under "Using Frequent Contacts"; where GroupWise discloses adding entries to the list in the first paragraph, after they have been used).

Referring to claims 24-25 and 38, GroupWise discloses storing the contact information in an address book. It is believed that GroupWise does not add a contact to the list if it is already stored and replaces an already existing entry with a matching new entry that is added to the

address book, which removes the original entry, but alternatively, it would have been obvious to one of ordinary skill in the art to update entries in this fashion as is well-known in the art. The Examiner takes Official Notice of this teaching. One would have been so motivated in order to prevent ambiguous information for the same contact and multiple instances of the same contact that waste memory.

Regarding claims 26 and 45, GroupWise teaches an automatically resolved contact entry based on a full or partial match selectable by a user via a user interface (see page 111, under "Tips" shaded box, 3rd bulleted item; where GroupWise discloses a dialog box allowing a user to choose a resolved contact entry).

Regarding claim 29, GroupWise teaches particular items in the data store being excluded from tracking (see pages 134 and 135, under "Viewing Groups, Organizations, or Resources in the Address Book"; where GroupWise discloses applying filters so that items in the data store are excluded and not displayed).

Regarding claims 30 and 47, GroupWise teaches excluding specific e-mail addresses (see pages 134 and 135, under "Viewing Groups, Organizations, or Resources in the Address Book"; where GroupWise discloses applying filters so that items in the data store are excluded and not displayed; and see pages 149-154; where GroupWise discloses specific filters including e-mail addresses are specified to exclude).

Regarding claims 31, and 34-36, GroupWise teaches an e-mail address and a friendly name (see page 130, the top Figure, which discloses a display name as well as an e-mail address); a number of times that the entry has been used (see page 124, under the heading "Using Frequent Contacts"; where GroupWise discloses in the first paragraph the number of times an

entry has been used); a date the e-mail was last sent to (see page 154, where GroupWise discloses the contact filter field "Delivered", which contains the date that a message was delivered on; and page 156, where GroupWise discusses the contact filter field "To", which combined with "Delivered" can be used for the date the e-mail was last sent to); a date the email address was last received from (see page 154, where GroupWise discloses the contact filter field "Delivered", which contains the date that a message was delivered on; and the contact filter field "From", which combined with "Delivered" can be used for the date the e-mail was last sent from); and a weight as taught by Atlas and Teare, *supra*.

Regarding claim 33, GroupWise teaches that the data store further includes a plurality of types of electronic files, including sent and received e-mail (see page 124, under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages); email addresses and contacts that exist within previous systems (see page 133, under "Sharing an Address Book with Another User"; where GroupWise discusses sharing another user's address book, which has previously been used on a previous system by a different user, including their email addresses and contacts in their address book); email stores located on public servers (see page 111, where GroupWise discloses the use of LDAP servers, and retrieval of contact information from those public servers); current and previous contact databases (see pages 129-131, where GroupWise discloses using a current contact database; and page 133, under "Sharing an Address Book with Another User"; where GroupWise discusses sharing another user's address book, which has previously been used on a previous system by a different user, including their email addresses and contacts in their address book); and data embedded within application electronic files including emails (see page 124,

under heading "Using Frequent Contacts"; where GroupWise teaches capturing addresses and contact information from sent and received email messages, created by e-mail clients) and data embedded within application electronic files, i.e. one or more database files. For example, each entry entered in the Address book (i.e. first figure on page 130) is a database file.

Regarding claim 42, GroupWise teaches a list capable of being browsed via a user interface (see Figure on page 124).

Referring to claim 43, GroupWise teaches selectively adding entries from the resolution list to an address book via a user interface. See "Creating Address Books" on pages 127-134.

4. Claims 23 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novell GroupWise 5.5 (as supported by "GroupWise User's Guide for Windows 95/98/NT" (hereinafter GroupWise) and the Novell articles entitled "GroupWise 5.x & 6.x" and "MAPI"), Smiga, Atlas, Teare, and U.S. Patent No. 5,923,848 to Goodhand et al. (hereinafter Goodhand).

Regarding claim 23, GroupWise, Smiga, Atlas, and Teare teach all the limitations of claim 23, (including storing the list in random access memory (Atlas; col. 3, lines 20-30)), except GroupWise, Smiga, Atlas, and Teare do not explicitly mention caching the list in a non-volatile storage medium. Goodhand teaches storing the list in random access memory (see column 18, lines 23-26; where Goodhand discloses storing the list in system memory or random access memory) and caching the list in a non-volatile storage medium (see column 19, lines 26-31; where Goodhand teaches the list being part of the user's profile, which is stored in memory storage devices). It would have been obvious to one of ordinary skill in the art, having the teachings of GroupWise, Smiga, Atlas, Teare, and Goodhand before him at the time the

invention was made, to modify the e-mail resolution system taught by GroupWise, Smiga, Atlas, and Teare to include storing the list in RAM and caching it in non-volatile storage, in order to provide quick access to the list for checking the names against the list as supported by Goodhand. Also, refer to Atlas at col. 5, lines 17-23.

Referring to claim 44, GroupWise, Smiga, Atlas, and Teare teach all the limitations of the claim, except automatically suggesting to a user that specific entries from the list be added to an address book via a user interface. However, Goodhand discloses a contact resolution method with a user interface that automatically suggests to a user that specific entries from the list be added to an address book via a user interface (Fig. 6c and col. 18, lines 2-4). It would have been obvious to one of ordinary skill in the art to modify the contact resolution method of GroupWise, Smiga, Atlas, and Teare to suggest adding an entry from the resolution list to an address book via a user interface, so the user could quickly and easily store the entry in the frequent contact or other address book for later reference.

Allowable Subject Matter

5. Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach or fairly suggest the combination of limitations that the applicant has claimed in claims 18-20. The prior art fails to teach adding replacement entries that are at least equal to the weights; not adding entries if entries in the list have higher weights than the new entry; choosing an entry at random to be replaced when multiple entries have the same lowest

weight; removing entries from the list when matching entries are added to a contact database; and not adding entries to a list if already stored in a contact database with indicated features corresponding to what the inventor has claimed.

Response to Arguments

7. Applicant's arguments, see pages 9-12 of Applicant's Remarks, filed 5/5/04, with respect to the rejection(s)of claim(s) 48 under GroupWise and Hedloy have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of GroupWise and Smiga.

8. Applicant's arguments, see pages 12-15 of Applicant's Remarks, filed 5/5/04, with respect to the rejection(s)of claim(s) 1 and 32 under GroupWise, Hedloy, Atlas, and Teare have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of GroupWise, Smiga, Atlas, and Teare.

Applicant argues the newly presented limitation of scanning the entire contents of a file, wherein the file is one of a word processor file, spreadsheet file, or presentation file, and extracting all contact information. While this new limitation does not appear to be supported by Hedloy, it was found upon further review that the prior art (i.e. Smiga) teaches parsing free form text and extracting all contact information. See Smiga at col. 5, line 59 – col. 6, line 13 and col. 8, line 61 – col. 9, line 25. Smiga teaches integrating email applications and word processor applications. Therefore, Smiga teaches a method of extracting contact information from free

form text (e.g. a word processor document is free form text) upon parsing the entire contents of the text, and thus teaches the newly presented limitation.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is currently (703) 305-7756, but will be (571) 272-4046 upon moving offices on October 20. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smb

RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173